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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,174	08/27/2001	Lane W. Lee	M-12038 US	5308

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MACPHERSON KWOK CHEN & HEID LLP
1762 TECHNOLOGY DRIVE
SUITE 226
SAN JOSE, CA 95110

EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,174

Applicant(s)

LEE ET AL.

Examiner

Calvin L Hewitt II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 15, 22, and 23 recite comparing an identifier read from a disk with a predetermined identifier. Applicant, however, only discloses storing a revocation list on the media that lists "rogue" devices and/or applications (paragraphs 174 and 176), collating an identifier using a verification function (paragraph 171) and different types of identifiers (paragraphs 299-301) and does not teach comparing the list and/or identifiers against other identifiers read from the media.

Claims 2-14 and 16-21 are also rejected as they depend from claims 1 and 15, respectively.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites determining whether an identifier is in a "written content" section of a media disk and comparing the identifier with one or more predetermined identifiers that is located in the "written content" section (see also claims 3, 5, 8 and 10-13). However, an identifier can be in a "pre-recorded" section and therefore would not be in a "written section". Hence, the operation of the method described by claim 1 is not clear and, not applicable, if the identifier is in a "pre-recorded" section. Similarly, claim 1 only recites detecting an authorized action if the identifier is in a "written content" section.

Claims 2-14 are also rejected as they depend from claim 1.

Claims 15, 22 and 23 recite "comparing the identifier with one or more predetermined types of identifiers for which a section located in the second portion for written content is not authorized if...". It is not clear to one of ordinary

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skill if the identifier is "not authorized" or a section of said predetermined type of identifier is "not authorized"

Claims 16-21 are also rejected as they depend from claim 15.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kataoka et al., U.S. Patent No. 5,857,021.

As per claims 1-14, Kataoka et al. teach a method for detecting unauthorized actions comprising:

- reading (e.g. record, play, get play key copy, open, close or create) an identifier on the media disk (media disk, CD, DVD, or other storage medium) wherein the identifier is located in one of: prerecorded content, written content or prerecorded and written content (abstract; figure 7)

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- an identifier that is one of a plurality of identifier on the media disk, associated with one or more files on a media disk, each identifier being written content or prerecorded content (figure 7)
- a media disk that is pre-recorded with an identifier (column 3, lines 35-48)
- an identifier that is a seed value for a key generator, wherein the key generator retrieves one or more keys from a key box for unlocking and decrypting files on a media disk (figure 7)
- a media disk coupled to an engine, device with an embedded engine, third party DRM protocol, an application running in an open computing environment or a clearinghouse server (figure 1)

8. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 15 and 17-23 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Harada et al., U.S. Patent 6,581,160.

As per claims 15 and 17-23, Harada et al. teach an apparatus for detecting unauthorized actions comprising:

- reading (e.g. access operation) an identifier on the media disk (media disk, CD, DVD, or other storage medium) wherein the identifier is located in one of: prerecorded content, written content or prerecorded and written content (column 7, lines 12-18; column/line 13/31-14/16)
- comparing the identifier on the media disk with one or more predetermined types of identifiers that are found in the "written content" section of a media disk (figures 3 and 4)
- detecting and "not authorizing" an identifier if the identifier is one of the predetermined types (column 9, lines 57-67; column/line 13/31-14/16)
- an identifier that is one of a plurality of identifier on the media disk, associated with one or more files on a media disk, each identifier being written content or prerecorded content (figure 3; column/line 8/27-9/42; 13/31-14/16)
- wherein one of the plurality of identifiers is unique to the media disk (column 8, lines 27-60)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harada et al., U.S. Patent No. 6,581,160 in view of Ansell et al., U.S. Patent No. 6,367,019.

As per claim 16, Harada et al. teach a method and system for protecting content comprising comparing an identifier against a revocation list (column 14, lines 3-16). Harada et al. do not specifically recite being able to detect a fraudulent identifier. Ansell et al. teach using MAC to verify the integrity of a stored identifier (column 6, lines 58-65). Therefore, it would have been obvious to combine the teachings of Harada et al. and Ansell et al. in order to a rogue content distribution system (CDS) ('160, column 5, lines 19-40) from posing as an authorized CDS.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Hillis teaches a method and system for authenticating media
- Lotspiech teaches for securely writing content to a portable media

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

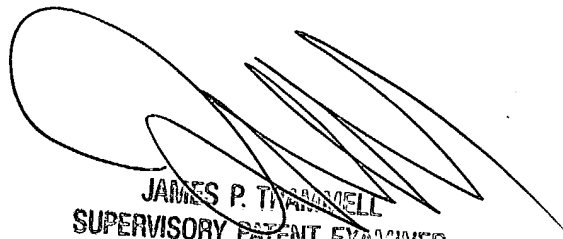
Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

July 25, 2004



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3000